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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Stefan Hofmair

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EXAMINER

CHOI, PETER Y

ART UNIT

PAPER NUMBER

1794

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/581,482	HOFMAIR ET AL.	
	Examiner	Art Unit	
	PETER Y. CHOI	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/25/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicants' election with traverse of Invention Group I, Species I from Species Group I and Species I from Species Group II, in the reply filed on April 13, 2009, is acknowledged. It should be noted that the Species Groups recited in the Restriction Requirement of March 12, 2009, appear to be obvious embodiments over each other and therefore the Species restriction is hereby WITHDRAWN.

2. The traversal is on the grounds that Examiner fails to provide any reasons as to why the Invention Group I and the Invention Group II lack unity of invention. This is not found persuasive because the inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the inventions lack the same or corresponding special technical features for the following reasons: Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (see MPEP 1850, 1893). Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

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As set forth in the Restriction Requirement of March 12, 2009, section 3, at least one independent claim of the application does not avoid the prior art, as demonstrated by the “X” reference on the International Search Report. Therefore, the special technical feature of the application is anticipated by or obvious in view of the prior art. Consequently, the invention does not relate to a single general inventive concept under PCT Rule 13.1. Additionally, the PCT International Search Report specifically recites that the claims are not novel and do not contain an inventive step over the prior art.

Claims 17-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and nonelected species, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Specification

3. The disclosure is objected to because of the following informalities: Applicants’ specification recites in various instances “according to Claim 1” or according to other claims. However, it is improper to directly reference the claims in the specification as the claims are subject to amendment. Therefore, the references to the claims are required to be removed.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-16, claim 1 recites that the electronic component is sealed against environmental influences. It is unclear exactly what influences would be within the scope of environmental influences, and what structure and composition are necessarily required of the first and second adhesive layer to seal the electronic component against environmental influences. For example, do “environmental influences” include washing and/or cleaning and/or other effects such as abrasion resistance? It is unclear exactly what type of environmental influences or environmental effects are intended.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-7 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by WO 01/75843 to Tirkkonen..

Regarding claims 1-3, 5-7 and 16, Tirkkonen teaches a textile label featuring a textile base layer, a transponder arrangement that is bonded to the textile base layer by means of a first adhesive layer, and a second adhesive layer, wherein the transponder arrangement features an antenna and at least one electronic component that is sealed against environmental influences by

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means of the first and the second adhesive layer (including page 1 line 1 to page 4 line 20, page 4 line 36 to page 8 line 13, Figures 1-8).

Regarding claim 2, the at least one electronic component includes a chip (page 5 lines 12-20).

Regarding claim 3, the second adhesive layer extends over the entire transponder arrangement in a plane fashion (page 3 lines 15-34, page 7 line 16 to page 8 line 13, Figures 1-8).

Regarding claim 5, the second adhesive layer consists of a hot-melt adhesive (page 3 line 36 to page 4 line 7).

Regarding claim 6, the antenna consists at least predominantly of copper (page 4 line 36 to page 5 line 10).

Regarding claim 7, the base layer features at least one of the group consisting of graphic and alphanumeric symbols (page 6 line 26 to page 7 line 4).

Regarding claim 16, Tirkkonen teaches a garment featuring a label according to claim 1 (page 6 line 26 to page 8 line 13).

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5, 7-10, 15, and 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,982,284 to Baldwin.

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Regarding claims 1-3, 5, 7-10, 15, and 16, Baldwin teaches a textile label featuring a textile base layer, a transponder arrangement that is bonded to the textile base layer by means of a first adhesive layer, and a second adhesive layer, wherein the transponder arrangement features an antenna and at least one electronic component that is sealed against environmental influences by means of the first and the second adhesive layer (column 1 line 14 to column 2 line 59, column 3 line 6 to column 5 line 48). It should be noted that paper appears to be within the scope of a textile base layer, as it is a non-woven structure made of fibers.

It should be noted that, as set forth above, the scope of the claim limitation requiring the electronic component to be sealed against environmental influences is unclear. However, since the prior art teaches a substantially similar structure and composition as the claimed invention, it is reasonable for one of ordinary skill in the art to expect that the invention of the prior art would behave in a substantially similar and/or identical manner, absent evidence to the contrary. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the textile label of the prior art, wherein at least one electronic component is sealed against environmental influences by the adhesive layers, motivated by the desire of protecting the electronic components any number of environmental effects including moisture which can degrade electronic components.

Regarding claim 2, the at least one electronic component includes a chip (column 5 lines 38-48).

Regarding claim 3, the second adhesive layer extends over the entire transponder arrangement in a plane fashion (Figures 1-4).

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Regarding claim 5, the second adhesive layer consists of a hot-melt adhesive (column 3 line 58 to column 4 line 5).

Regarding claim 7, the base layer features at least one of the group consisting of graphic and alphanumeric symbols (column 1 lines 14-55).

Regarding claim 8, an additional textile layer is bonded to the remainder of the label by means of the second adhesive layer (column 1 line 14 to column 2 line 59, column 3 line 6 to column 5 line 48, Figures 1-4). It should be noted that paper appears to be within the scope of a textile layer, as it is a non-woven structure made of fibers.

Regarding claim 9, the additional textile consists of an upper label (column 1 line 14 to column 2 line 59, column 3 line 6 to column 5 line 48, Figures 1-4).

Regarding claim 10, the upper label features at least one of the group consisting of graphic and alphanumeric symbols (column 1 lines 14-55).

Regarding claim 15, the additional textile layer consists of part of a garment (column 6 lines 11-19). Since the label is attached to a garment, the label including the additional textile layer appears to be within the scope of the claimed limitation as being part of a garment.

Regarding claim 16, Baldwin teaches a garment featuring a label according to claim 1 (column 6 lines 11-15, claims 18-32).

Claim Rejections - 35 USC § 103

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin as applied to claims 1-3, 5, 7-10, 15, and 16 above, USPN 4,783,646 to Matsuzaki.

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Regarding claim 4, the prior art does not appear to teach that the first adhesive layer consists of a polyester adhesive. However, Matsuzaki is classified in the same field in the art as Baldwin, and teaches a substantially similar identification label to be attached to an article, the label comprising a transponder and multiple layers of adhesive, wherein the adhesives comprise a polyester adhesive (Matsuzaki, column 1 line 6 to column 3 line 27, column 3 line 50 to column 6 line 27). Matsuzaki teaches that polyester adhesives are used to form a surface flatness suitable for printing an article name or the like. It would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art, wherein the adhesives comprise the polyester adhesive as taught by Matsuzaki, as Matsuzaki and Baldwin are classified in the same field in the art, and motivated by the desire of forming a conventional identification label with adhesives known in the art to be predictably suitable for use in identification labels, to form a surface flatness suitable for printing an article name or the like.

11. Claims 6 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin as applied to claims 1-3, 5, 7-10, 15, and 16 above, and further in view of Tirkkonen.

Regarding claim 6, the prior art teaches a radio frequency identification device including a foil antenna coil and an integrated circuit. However, the prior art does not appear to teach that the antenna consists at least predominantly of copper. Since the prior art is silent as to the composition of the radio frequency identification device, it would have been necessary and therefore obvious to look to the prior art for conventional compositions of radio frequency identification devices. Tirkkonen provides this conventional teaching, showing that it is known

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in the identification label art to form a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein the transponder comprises a radio frequency identification device formed from copper wire (Tirkonnen, page 1 line 1 to page 4 line 20, page 4 line 36 to page 8 line 13, Figures 1-8). It would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art, such that the foil antenna coil of the radio frequency identification device comprises copper, as taught by Tirkonnen, motivated by the desire of forming a conventional identification label formed from metals known in the art to be predictably suitable for radio frequency identification devices.

Regarding claims 11-14, the prior art teaches that the label may be applied to a product by conventional methods. However, the prior art does not appear to teach that the upper layer protrudes over the base layer on at least one side, that at least a portion of the region of the upper label that protrudes over the base layer can be separated from the remainder of the label, and that the region of the upper label that protrudes over the base layer is sewn and/or bonded to a garment. Since the prior art is silent as to the method of attaching the label to a garment, it would have been necessary and therefore obvious to look to the prior art for conventional methods of attaching labels to garments. Tirkkonen provides this conventional teaching, showing that it is known in the identification label art to form a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein at least a portion of a textile layer protrudes over the remaining portion of the layer (as shown in Figures 5-7 of Tirkonnen), such that the label is attached at its edges by sewing gluing to a product (Tirkonnen, page 1 line 1 to page 4 line 20, page 4 line 36 to page 8

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line 13, Figures 1-8). It would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art, such that a portion of a textile layer protrudes over the base layer to be sewn or glued to a garment, as taught by Tirkonnen, motivated by the desire of forming a conventional identification label with conventional attaching methods known in the art to be predictably suitable for attaching identification labels to products such as garments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER Y. CHOI whose telephone number is (571)272-6730.

The examiner can normally be reached on Monday - Friday, 08:00 - 15:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 1794

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